



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,607	04/08/2004	Joachim Ernst Kramer	P06300US02-PHI 1483	9485

27142 7590 07/13/2006

MCKEE, VOORHEES & SEASE, P.L.C.
ATTN: PIONEER HI-BRED
801 GRAND AVENUE, SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER

IBRAHIM, MEDINA AHMED

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,607

Applicant(s)

KRAMER, JOACHIM ERNST

Examiner

Medina A. Ibrahim

Art Unit

1638

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's response filed 04/19/06 in reply to the Office action of 12/19/05 has been entered. Claims 7, 9, 16 and 25-28 are amended. The terminal disclaimer filed on 04/19/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US pat 6,774,290 has been reviewed and is accepted. The terminal disclaimer has been recorded.

All previous objections and rejections not set forth below have been withdrawn in view of Applicant's amendment and/or upon further consideration. This Office action contains NEW GROUNDS of rejection and Rule 105 (see Attachment) not necessitated by Applicant's amendment, and is made Non-Final. Any inconvenience is regretted.

Claims 1-36 are pending and are examined.

Written Description

Claims 1-14 and 17-36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is repeated for the reasons of record as set forth in the last Office action of 12/19/05.

Applicant's arguments filed 04/19/06 have been considered but are not deemed persuasive for the reasons of record. Applicant cites the decision in *Ex parte Carison* (B.P.A.I. 2005) to support description of hybrid seed/plants produced from inbred line PH94T. This is not found persuasive because the decision by the Board is unpublished opinion, therefore, cannot be cited as precedent. Applicant's arguments regarding the

Art Unit: 1638

deposit of the inbred seed and the cited *Enzo Biochem. Inc.*, (323 F3d at 965, 63 U.S.P.Q. 2d at 1613(2002)) and Eli Lilly (1997) have been addressed in the previous Office action of 12/19/05 and will not be discussed in this Office action.

Applicant cites Sharopova et al (Plant Mol Biol. 48 (5-6):463-481(2002)) and Lee et al (Plant Mol Biol. 48 (5-6):463-481(2002)) to show the availability of marker information including primer sequences and map information, and uses thereof. This is not found persuasive because the development and mapping of SSR markers having no known linked trait would not provide adequate written description for hybrid seed/plants produced from inbred parent lines with unknown genetic complement. The instant specification provides the SSR profiles of the exemplified variety only. The SSR profiles of all other second inbred parents involved in the breeding are unknown. In addition, the rejected claims are drawn to hybrid seed and plants and methods of using said seed/plant rather than methods of using SSR to identify progeny plants inbred. Therefore, for all the reasons discussed above and in the last Office action, the claimed invention lacks adequate written description.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1638

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 and 17-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fullerton et al (US Pat. 6,169, 234 B1)

The claims are drawn to seed comprising at least one set of chromosomes of inbred maize PH94T, plant produced from said seed; hybrid corn plant/seed produced by crossing the inbred line PH94T with plants of another inbred line, and a method for using said hybrid plants/seeds to produce further subsequent generation plants/seed. The claims are also drawn to various breeding techniques used to generate corn plants/seeds.

Fullerton et al teach hybrid maize designated 36B08, seeds and plants of said hybrid; plants and seed derived from said hybrid, and a method of producing hybrid seed/plant comprising in its material a transgene that confers a desired agronomic trait such as male sterility or resistance to herbicide or diseases. The cited reference teaches the development of hybrid maize variety by using maize breeding programs involving selection of plants from various germoplasm pools, selfing or crossing of the selected plants to produce inbred and hybrid lines. The cited reference also teaches backcrossing and pedigree breeding, genetic marker enhanced selection and

Art Unit: 1638

transformation methods to transfer a desirable trait between plants (see at least columns 1-5). The seed and plants of the instant claims and those of the prior art share morphological and agronomic characteristics such as dark green leaves; moderate pollen shed; yellow anther; light green silk and light green glumes; no bar glumes; light green fresh husk; buff dry husk; husk tightness (6); slightly curved row; average ear taper; red cob; average staygreen; resistance to common rust (*puccinia sorghi*); resistance to Stewart's Wilt (*Erwinia stewartii*); resistance to Fusarium and Gibberella ear and kernel rots (see columns 13-16). Given all these similarities between the prior art hybrid and the inbred line PH94T, the prior art plant and seed would comprise at least one set of chromosomes of the inbred line PH94T. Therefore, the claimed seed/plant and those of the prior art are indistinguishable. The Examiner does not have sufficient facts to determine whether the corn plant and seeds are inherently the same and cannot conclude that the claimed subject matter would have been obvious since it cannot be determined whether the corn plants differ. Where the prior art product seems to be identical, except that the prior art is silent to a characteristic or property claimed, then the burden shifts to Applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention. See *In re Best* 195 USPQ 430, 433(CCPA 1977).

Remarks

Claims 13-16 are free of the prior art of record.

Claims 15 and 16 are allowable.

Art Unit: 1638

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM . Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/5/06

Mai

MEDINA A. IBRAHIM
PRIMARY EXAMINER

Medina A. Ibrahim

REQUEST FOR INFORMATION UNDER 37 CFR § 1.105

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

2. This request is being made for the following reasons:

Applicant is claiming seed/plant comprising at least a set of chromosomes of inbred line PH94T; hybrid maize seed/plant produced by crossing maize plants of inbred line PH94T with plants of another different maize inbred line and plant comprising at least 95% of the alleles of inbred line PH94T. However, the specification is silent about what starting materials and methods were used to produce line PH94T. The requested information is required to make a meaningful and complete search of the prior art.

3. In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information:

(i) What were (are) the original parental corn lines used to produce inbred line PH94T. Please supply all designations/denominations used for the original parent lines and any corn variety produced using said original parental lines. Please supply information pertaining to the lineage of the original parental lines back to any publicly available varieties.

(ii) What method and method steps were used to produce corn line PH94T?

(iii) At or before the time of filing of the instant application or any provisional application to which benefit is claimed, had any of said parental corn lines or progeny

Art Unit: 1638

therefrom been disclosed or made publicly available? If so, under what designations/denomination and under what conditions were said parent corn lines or progeny disclosed or made publicly available and from when to when?

(iv) At or before the time of filing of the instant application or any provisional application to which benefit is claimed, were any other corn lines produced by said method using said original parental corn lines, and if so, had said produced corn lines been publicly available or sold? If so, under what designations/denomination and under what conditions were said other corn lines disclosed or made publicly available and from when to when?

4. If Applicant views any or all of the above requested information as a Trade Secret, then Applicant should follow the guidance of MPEP § 724.02 when submitting the requested information.

5. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure. Please point to the specific sections where the relevant information can be found.

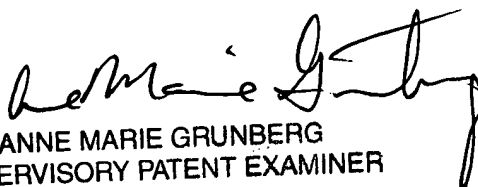
6. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any

Art Unit: 1638

supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

7. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

8. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.


ANNE MARIE GRUNBERG
SUPERVISORY PATENT EXAMINER